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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,288	03/21/2001	Noriko Ito	14419	4794

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SCULLY SCOTT MURPHY & PRESSER, PC  
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GARDEN CITY, NY 11530

EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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08/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/814,288

Applicant(s)

ITO, NORIKO

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

1. Claims 1-17 have been examined. Application 09/814,288 (ADVERTISEMENT PROVIDING SYSTEM AND METHOD) has a filing date 03/21/2001 and foreign priority of 03/30/00.

**Response to Amendment**

2. In response to Non Final Rejection filed 03/07/2007, the Applicant filed a Request for Reconsideration on 06/07/2007.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (U.S. 6,571,279) in view of Hall et al (US 6,026,375) and further in view of Walter (US 6,334,110).

As per claims 1, 9 and 17, Herz teaches:

An advertisement providing system comprising a communication line, one or more communication dealer terminals, one or more consumer terminals and one or more company terminals, these terminals being interconnected by the communication line, wherein:

each communication dealer terminal includes a means for storing advertisement data and also consumer's position data and taste data, a means for selecting advertisement data for each consumer by taking the consumer's position data and taste data, and a current time into considerations (see Herz column 25, line 10 – column 26, line 62; column 11, lines 52-55; "time of day"). Herz does not expressly teach and a means for calculating a schedule time of consumer's arrival at a shop from a present position of the consumer and for transmitting the schedule time to a company terminal. However, Hall teaches "a method of processing an order from a mobile customer comprises receiving an order from a mobile customer, wherein the order includes customer identifying information; receiving customer location information from a location determination system; identifying at least one facility capable of completing the order; determining an estimated time of arrival of the customer at each identified facility using the customer location information; determining an amount of time needed by each identified facility to complete the order; and determining which facility of the at least one identified facility is capable of completing the order prior to the customer's estimated time of arrival at the determined facility" (see column 2, lines 49-61). Herz discloses in column 26, lines 49-60 "Once relevant products are identified, a user en route to a destination near a vendor's store can pre-order their groceries or other merchandise directly so that the user could simply pick up their pre-packaged grocery order at the time of arrival at the store. For example, an advertisement for a product on an electronic billboard could easily be pre-ordered from the user's automobile or device". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

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application was made, to know that once a customer is en route to a destination near a vendor's store identifies relevant products, said customer would preorder their order and the Herz system would determine the estimated time of arrival of said customer to said vendor's store based upon said customer's location, as taught by Hall . This schedule time information would be used by said store to reduce waiting time of said customer upon arrival at said store.

each consumer terminal includes a means for displaying advertisement data received from a communication dealer terminal, a means for transmitting the consumer terminal's position data to the communication dealer terminal, and a means for transmitting reservation request data for a product or a service selected by the consumer on the basis of the advertisement data received (see Herz column 26, lines 49-62); and

each company terminal includes a means for producing advertisement data and transmitting the produced advertisement data to the communication dealer terminal (see Herz column 16, lines 7-34),

a means for receiving the reservation request data via the communication dealer terminal and executing a reservation process, a means for checking, when the consumer comes to a shop, whether the consumer has requested a reservation and outputting a result of the checking (see Herz column 26, lines 29-62)

Herz teaches wherein the communication dealer terminal further includes means for calculating an advertisement effect based on the transmitted reservation request data of the consumer (see Herz column 16, lines 22-25; column 18, lines 1-6; column

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25, lines 5-15), but fails to teach said means determining a contract link factor from a ratio of a purchase activity to a number of times of an advertisement distribution, and calculating the advertisement effect based on the contract link factor and a sales increase ratio of the purchase activity before and the contract link factor after the advertisement distribution. However, Walter teaches a system that calculates the effectiveness of an advertisement campaign using the sale increase ratio of purchase activity (i.e. units sold) before and after said advertisement distribution (see Walter figure 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would profile the web pages of on-line vendors and of users that participate in transaction on-line, would collect transaction data (see Herz col 19, lines 1-20) and users' click stream or impressions relating to ads (see Herz col 16, lines 22-35) and would determine the purchase activity before and after the distribution of said ads, as taught by Walter in order to determine the effectiveness of an advertisement campaign.

As per claims 2 and 10, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the advertisement data as electronic mail to the consumer terminal (see Herz column 8, lines 51-65).

As per claims 3 and 11, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the consumer terminal transmits the reservation request data as electronic mail to the communication dealer terminal (see Herz column 25, lines 25-67).

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As per claims 4 and 12, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the communication dealer terminal transmits the reservation request data as electronic mail to the company terminal (see Herz column 26, lines 29-62).

As per claims 5 and 13, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the communication line is an Internet system (see Herz column 25, lines 55-67).

As per claims 6 and 14, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the means for calculating the scheduled time of the consumer's arrival calculates the schedule time based on the present position of the consumer, the position of the shop as described in the advertisement and the present time. The same rejection applied to claim 1 regarding this missing limitation is also applied to claim 6.

As per claims 7 and 15, Herz, Hall and Walter teach:

The advertisement providing system according to claim 1, wherein the communication dealer terminal further includes a means for calculating advertisement effect from transmitted reservation request data of consumers from the contract of advertisement requested to it. Walter teaches a system that calculates the effectiveness of an advertisement campaign using the sale increase ratio of purchase activity (i.e. units sold) before and after said advertisement distribution (see Walter figure 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would profile the web pages of on-

line vendors and of users that participate in transaction on-line, would collect transaction data (see Herz col 19, lines 1-20) and users' click stream or impressions relating to ads (see Herz col 16, lines 22-35) and would determine the purchase activity before and after the distribution of said ads, as taught by Walter in order to determine the effectiveness of an advertisement campaign.

As per claims 8 and 16, Herz, Hall and Walter teach:

The advertisement providing system according to claim 7, but fails to teach wherein the communication dealer terminal further includes a means for determining advertisement fee from the advertisement effect. The same argument made in claim 7 is also made in claims 8 and 16.

#### **Response to Arguments**

4. Applicant's arguments filed 06/07/2007 have been fully considered but they are not persuasive. The Applicant argues that Walter does not disclose or suggest a contract link factor, that is, a ratio of purchase activity to number of times of advertisement distribution and does not disclose a system that calculates the effectiveness of an advertisement campaign using the sale increase ratio and the contract link factor. The Examiner answers that the Applicant is repeating the claimed language without explaining the meaning of said claim language. Furthermore, Applicant's specification only explained said limitation in page 14 where it recites that purchase link factor is the relationship (i.e. ratio) between distributed offers and purchased created from said offers. Walter teaches finding a relationship between offers and purchases and also teaches calculating the number of units sold with the promotion



(i.e. purchase link factor) prior and after the duration of a promotion (see figure 9). Therefore, contrary to Applicant's argument, Walter teaches Applicant's claimed invention.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

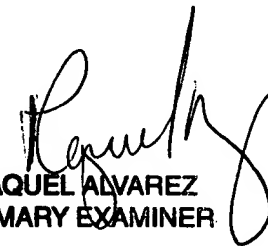
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra  
August 11, 2007



RAQUEL ALVAREZ  
PRIMARY EXAMINER